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Jeffry Grainger

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EXAMINER

MOONEYHAM, JANICE A

ART UNIT

PAPER NUMBER

3629

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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3 MONTHS

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

09/733,616

Applicant(s)

GRAINGER, JEFFRY

Examiner

Janice A. Mooneyham

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-17, 19-23, 32-49, 51-53 and 58-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 11-17, 19-23, 32-49, 51-53 and 58-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This is in response to the applicant's communication filed on October 30, 2006, which is a supplemental response to the communication filed on August 21, 2006. Claims 11-17, 19-23, 32-49, 51-53 and 58-64 are currently pending. Claims 20, 32-33, 36-41, 45, 48-49, 58, and 63-64 have been amended. Claims 1-10, 18, 24-31, 50 and 54-57 have been cancelled.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 32-44 and 63 are rejected under 35 U.S.C. § 112, first paragraph, as being of undue breadth.

A "single means" claim, i.e. where a means recitation does not appear in combination with another recited element or means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. See *In re Hyatt*, 218 USPQ 195, (CAFC 1983) and MPEP 2164.08(a).

#### **2164.08(a) Single Means Claim**

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In *re Hyatt*, 708 F.2d 712, 218 USPQ 195 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor). When claims depend on a recited property, a fact situation comparable to *Hyatt* is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor. Although the court in *Fiers v. Sugano*, 984 F.2d 164, 25 USPQ2d 1601 (Fed. Cir. 1993) did

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not decide the enablement issue, it did suggest that a claim directed to all DNAs that code for a specified polypeptide is analogous to a single means claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 51-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant has claims 51-53 depending on claim 50 which has been cancelled.

4. Claims 32-44 and 63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 32-44 depend on claim 63. Claim 63 is directed to a system. However, claims 32-44 are directed to instructions, not structure. Furthermore, claim 63 only defines a processor. It takes more than a processor to execute the instructions of the computer-readable medium.

5. Claims 34 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 34 and 35 depend on claim 32 and claim the limitation of *wherein the database is a local/remote database in communication with a local computer network/Internet*. Claim 32 depends on claim 63 and reads on the set of instructions. There is no positive recitation of a database in the claims.

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6. Claims 11-17, 19-23 46-49, and 58-62, rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 45 has a limitation of providing for the transmission of the electronic information statement. This is not a positive recitation. Providing for the transmission is simply supplying a means to transmit. There does not have to be an actual transmission to fulfill the language of the claim limitation. All claims depending on claim 45 have the same deficiency.

7. Claims 48-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 48 is directed to a limitation of allowing a user to review one or more electronic documents. Allowing a user to review is distinct from the positive step of actually reviewing the document. Allowing is simply permitting the user to review at some point in time.

8. Claim 59 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what the applicant is trying to claim by wherein determining that a patent application corresponding to the electronic information disclosure statement is being electronically filed in the patent office comprises receiving user input indicating that the patent application is being electronically filed.

**Claim Rejections - 35 USC § 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim 64 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106 states as follows:

**1. Non-statutory Subject Matter**

- Claims to computer-related inventions that are clearly non-statutory fall into the same general categories as non-statutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "**descriptive material**." □P8□
- Descriptive material can be characterized as either "**functional descriptive material**" or "**nonfunctional descriptive material**." □P8□
- 
- "**Functional descriptive material**" consists of data structures and computer programs which impart functionality when encoded on a computer-readable medium. □P8□
- "**Nonfunctional descriptive material**" includes but is not limited to music, literary works and a compilation or mere arrangement of data. □P8□
- Both types of "**descriptive material**" are Non-statutory when claimed as **descriptive material per se**. When functional descriptive material is **recorded on some computer-readable medium** it becomes structurally and functionally interrelated to the medium and will be statutory in most cases. □P8□
- When nonfunctional descriptive material is recorded on some computer-readable medium, it is not structurally and functionally interrelated to the medium but is **merely carried by the medium**. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. □P8□
- - (a) **Functional Descriptive Material: "Data Structures"**  
**Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se** □P9□
- Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical

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"things" nor statutory processes. Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. □P9□

- In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the medium which permit the data structure's functionality to be realized, and is thus statutory. □P9□
- Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things," nor are they statutory processes, as they are not "acts" being performed. □P9□
- In contrast, a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer program and the medium which permit the computer program's functionality to be realized, and is thus statutory. □P9□
- **Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process** and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as Non-statutory functional descriptive material. □P9□
- When a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim. □P10□
- When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim. □P10□
- (b) **Nonfunctional Descriptive Material**
- Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" is not a process, machine, manufacture or composition of matter. □P10□

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10. Claim 64, as written, is claiming only instructions. Thus, the claim is not statutory. To render the claim statutory, the applicant may amend to define the invention as:

A computer software program embodied on a computer-readable medium, the computer software program comprising a set of instruction that when executed by a computer cause the computer to perform the steps of:

providing an interface,

receiving, from the user via the interface, a signal ....

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 11-17, 19, 21-23, 32-49, 51-53 and 58-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al (US 2003/0046307) (hereinafter referred to as Rivette) in view of Petruzzi et al (US 6,049,811) (hereinafter referred to as Petruzzi) in view of Tran (US 2001/0049707).

Referring to Claims 32-45, 58-59, 63 and 64:

Rivette discloses a computer-implemented method, system and software, comprising:



a processor, a database and a computer interface with a web browser (Figures 3 (316), 6, 111, 117, and Figure 8 (808) and paragraph [0290] and [0407];

providing a computer interface for a user to review one or more electronic documents, wherein the interface is configured to provide a prompt to allow the user to identify at least one electronic document as being relevant to a patent application [0393] [0396] [0407];

receiving from the user via the interface, a signal indicating that the at least one electronic document should be disclosed to the patent office [1157] [1193];

in response to the signal, extracting, via an automated process from the at least one electronic document, a set of information [1193].

While Rivette discloses searching and storing and retrieving relevant documents to a patent application, Rivette does not disclose using the information in the process of generating an information statement in a form suitable for filing with an official patent office, or transmitting the document to the patent office.

However Petruzzi discloses an electronic information disclosure statement and incorporating, with an automated process, at least some of the extracted information from the electronic document into an electronic information statement wherein the at least one electronic document includes information corresponding to a plurality of fields in the electronic information disclosure statement, and wherein incorporating at least some of the extracted information

comprises storing the information in the corresponding plurality of fields in the IDS (Figure 2 (Forms 39) col. 2, lines 65-67 col. 5, line 48 thru col. 6, line 7 The Form 1449 for submitting information in the form of patents, publications, etc is provided, operator is prompted for references, a brief description of each reference and the relevance. After information is inputted, the computer automatically generates a first draft).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the searching and storage of relevant documents disclosed in Rivette the electronic IDS taught in Petruzzi so that once the relevant documents are identified, the applicant is able to comply with the rules and regulations of the patent office by submitting the relevant prior art as required.

Rivette nor Petruzzi disclose transmitting the electronic information statement to the official patent office.

However, Tran discloses providing for the transmission of the statement to an official patent office (Figure 2C File application, [0007] generation and filing of a complete patent application [0017] techniques support electronic patent filing).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the search and retrieval disclosed in Rivette and the electronic IDS disclosed in Petruzzi the transmission taught in Tran so as to provide support for electronic patent filing that substitutes an electronic form of an

IDS for a paper copy and to facilitate and enhance the procurement and trading of IP assets.

**NOTE:** Claim Construction - "Automatically" - Without human interaction such that a human does not have to intercede and alter the flow. Process may be automatic even though human initiates or may interrupt *Collegenet, Inc. v Applyyourself, Inc.* (CAFC, 04-1202,-1222,-1251, 8/2/2005)

Referring to Claim 46-47:

Tran discloses wherein providing for the transmission of the electronic information disclosure state to the official patent office comprises printing the electronic information disclosure state to create a statement for mailing to the patent office or transmitting the statement electronically to the patent office ([0046] Express Mail Declaration, correct Mailing Label Number; ([0017] [0048] [0049]).)

Moreover, the Examiner takes Official Notice that transmission of patent documents via mail to the office is old and well known as is evidenced by the fact that it was an established business principle to use a certificate of mailing when mailing applications to the office.

It would have been obvious to one of ordinary skill in the art at the time of the invention to print and mail the application since it was known in the art that mailing was a reliable way of transmitting the application, including the IDS, and for many years was the only way to transmit the application, including the IDS, without having to hand deliver the papers.

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Referring to Claims 48-49:

Petruzzi discloses **allowing** a user to review via the computer interface the at least one *relevant* electronic document for disclosure to a patent office (col. 5, line 48 thru col. 6, line 7 through the use of a wizard, the operator is prompted for references).

NOTE: The claim language is *allowing* a user to review the at least one relevant electronic document for disclosure to a patent office. Using terms like "allowing" or "permitting" an action, e.g. "allowing a user to search a database", the steps are distinct from actually doing the action, e.g. searching.

Applicant has also failed to identify what applicant means by the term "relevant" document. The Examiner has interpreted this as relevant prior art.

Referring to Claim 60:

Petruzzi discloses wherein the electronic information disclosure statement is a document separate from but related to the patent application and is configured to meet a set of requirements of the patent office (The Examiner takes Official Notice that an Information Disclosure Statement is a related but separate document to a patent application and wherein the electronic information disclosure statement is configured to meet a set of requirements of the patent office. (Also, see Petrucci (col. 5, line 48 thru col. 6, line 7 discloses Form 1449 (IDS) and col. 16, lines 34-39 – Petrucci discloses wherein the invention can be modified to incorporate the patent laws and rules of any foreign country)

Referring to Claim 61:

Petruzzi discloses receiving from the user a set of general information to be included in the electronic IDS, the information comprising information about the patent application to which the IDS is related (col. 5, line 48 thru col. 6, line 7 operator is prompted for references, a brief description of each reference and the relevance).

Referring to Claim 62:

Rivette discloses downloading the at least one electronic document from the Internet [0373-0379].

Referring to Claim 11:

Rivette discloses wherein the electronic document is downloaded from a database coupled to the computer network [0373-0379].

Referring to Claims 12-14:

Rivette discloses saving the electronic IDS in a database, wherein the database is a local database or a remote database ([0373-0379] [0406-0408] Figure 54).

Referring to Claim 15:

Tran discloses providing access to the IDS to multiple users over the Internet [Figure 1 [0043] one or more client workstations are connected).

Referring to Claim 16:

Tran discloses prompting the user for an access code when the user request access to the electronic IDA, wherein when the correct code is provided, the

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user is granted access and when the correct code is not provided, the user is denied access ([0019] users are logged in).

Referring to Claim 17:

Tran discloses providing the user with instructions on when an IDS is to be disclosed to a patent office ([0041] user is prompted to list any publication or planned disclosure of the invention).

Referring to Claim 19:

Tran discloses determining that a patent application corresponding to the IDS is being electronically filed in the patent office and transmitting the IDS with the patent application ([0017] [0048] [0049]).

Referring to Claims 21-23:

Rivette discloses wherein the electronic document is an electronic version of a US patent, an electronic version of a foreign patent document or an electronic version of a publication [0321] [0376].

12. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette, Petruzzi and Tran as applied to claim 45 and 63 above, and further in view of Takano et al (US 6,434,580) (hereinafter referred to as Takano).

Referring to Claim 20:

Rivette, Petruzzi and Tran disclose the method and system of claims 45 and 63.

Rivette, Petruzzi and Tran do not disclose generating a letter when the application information is filed with the patent office.

However, Takano discloses generating a letter via the computer when the application is filed in patent office (Figure 15, col. 37 thru col. 16, line 14, col. 16, lines 34-45 and Figure 18).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the transmittal of a letter as taught by Takano with IDS form of Petruzzj and Tran so as to provide notification and proof that the document was received by the patent office.

***Response to Arguments***

13. Applicant's arguments filed October 30, 2006 have been fully considered but they are not persuasive. A review of the Remarks/Arguments reveal that the arguments are directed to the newly amended claim limitations. Applicant's arguments with respect to the newly amended claims have been considered but are moot in view of the new ground(s) of rejection.

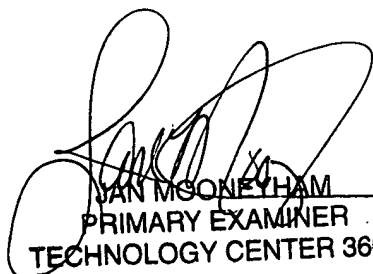


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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